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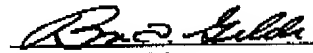
Application Serial No: 09/593,914 Confirmation No: 8319  
Date Filed: June 14, 2000  
Application Title: Probes, Probe Sets, Methods And Kits Pertaining To The  
Detection, Identification And/Or Enumeration Of Yeast,  
Particularly In Wine  
Applicants: Hyldig-Nielsen et al.  
Group Art Unit: 1634  
Examiner: C. Myers  
Application Status: Appeal Brief Filed  
Action Type: Reply To The "Decision On Petition" Dated March 3, 2004

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37 C.F.R. § 1.8

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Brian D. Gildea  
Reg. No. 39,995

Attention: Bruce Campell, Director, Technology Center, 1600: Total Pages Sent: 4

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Petition Under 37 C.F.R. § 1.144 or § 1.181

Commissioner for Patents  
Dear Sir or Madam:

## Preliminary Statement

In the above captioned application, the Examiner issued a restriction requirement in Office Action paper No. 9 (Office Action dated July 18, 2001). Applicants did enter traverse of the restriction requirement as well as make appropriate argument and a request for reconsideration, in reply to said Office Action, by submission dated January 17, 2002. Applicants did timely file a petition under 37 C.F.R. § 1.144 requesting review of the Examiner's decision by paper dated August 22, 2003. Applicants received a Decision On Petition dated March 3, 2004 wherein the petition under 37 C.F.R. § 1.144 was DENIED.

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In response to said Decision On Petition, Applicants will submit a Supplemental Appeal Brief arguing that the issue of whether or not the restriction requirement was properly issued by the Examiner is now ripe for consideration for the Board of Appeals. In order to not waive any of Applicant's rights, this new Petition under 37 C.F.R. § 1.144 or § 1.181 is being filed. Applicants hereby petition for review of the Examiner's decision with regard to a restriction requirement as set forth in Office Action paper No. 9 as well as review of the Decision On Petition dated March 3, 2004.

#### **Argument In Support Of Request To Withdraw Restriction Requirement**

In the Office Action of Paper No. 9, the Examiner took the position that, with respect to claims 10, 11, 21, 22, 34, 61 and 62, Applicants presented claims in improper Markush format. The Examiner cited to *Ex parte Markush*, 1925 C.D. 126 and *In re Weber*, 198 U.S.P.Q. 334<sup>1</sup> as legal support for this position. The Examiner's argument also relied upon 35 U.S.C. § 121 as statutory support for the restriction requirement. Specifically the Examiner stated: "Restriction to one of the following inventions is required under 35 U.S.C. 121:" (See page 2 of the Office Action dated July 18, 2001. At page 4 of the Office Action dated July 18, 2001, the Examiner states: "These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. § 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. § 121."

In the Decision On Petition dated March 3, 2004, the Discussion section states: "The examiner has not set forth any rejection based upon 35 U.S.C. 121 in this application." Appellants respectfully submit that based upon review of the Office Action dated July 18, 2001, it is apparent that the sole statutory basis relied upon for issuance of the restriction requirement is 35 U.S.C § 121. Moreover, as discussed in detail below, such action has been considered by the courts to be improper. While it is noted that sections of the Manual of Patent Examining Procedure (MPEP) have been

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<sup>1</sup> The proper citation to *In re Weber* is 580 F.2d 455, 198 U.S.P.Q. 328 (CCPA, 1978). Nevertheless, the case cited at 198 U.S.P.Q. 334 (*In re Haas*) does pertain to same question of law.

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relied upon to deny the petition, it is well accepted that the MPEP must comply with, and cannot overrule, case law.

Applicants hereby respectfully traverse the restriction requirement recited in Paper No. 9 (Office Action dated July 18, 2001) as being clearly contrary to the express holdings of both *In re Weber* and *In re Haas*. *In re Weber* expressly holds that:

It is apparent that § 121 provides the Commissioner with the authority to promulgate rules designed to Restrict an Application to one of several claimed inventions when those inventions are found to be "independent and distinct". It does not, however, provide a basis to an examiner acting under the authority of the Commissioner to Reject a particular Claim on that same basis. *In re Weber*, 580 F.2d 455, 458, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978)

We hold that a rejection under § 121 violates the basic right of the applicant to claim his invention as he chooses (emphasis added). *In re Weber*, 580 F.2d 455, 459, 198 U.S.P.Q. 328, \_\_ (CCPA, 1978)

A similar holding has been entered in *In re Haas*, 198 U.S.P.Q. 334.

Accordingly, it is clear from the precedent cited by The Office in the Office Action dated July 18, 2001 (*In re Weber*), the legal issue of whether or not The Office may impose a restriction requirement to a single claim has been decided against The Office. It is well settled that such a requirement violates 35 U.S.C. 121, where the applicant is statutorily entitled to claim his invention as he deems proper. This is true whether or not the inventions are determined by The Office to be independent and distinct. Accordingly, it is improper for the Examiner to demand that the claims be amended to redact all Seq. ID Nos., other than Seq. ID No. 1, from any of claims 10, 11, 21, 22, 34, 61 or 62.

Applicants further note that each Group that the Examiner argues is a separate invention (each distinct Seq. ID No. (e.g. 1-11)) is classified in Class 435, subclass 6 and Class 536, subclass 24.32. Thus, for purposes of a search, there is no additional burden

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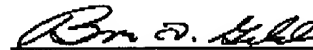
on The Office since the same class and subclasses must be searched, and no additional Class or subclass must be searched, whether or not a restriction requirement is imposed.

Additionally, Appellants take the position that said claims are generic and do not use improper Markush format. Accordingly, Appellants takes the position that the restriction requirement recited in paper No. 9 is improper. Reconsideration of the restriction requirement issued in the Office Action dated July 18, 2001 and affirmed by the Decision On Petition dated March 3, 2004 is hereby requested.

#### Fees

The Office is hereby authorized to deduct the required fee for consideration of this petition, believed to be \$ 130.00, from Deposit Account No. 02-3240.

Respectfully submitted  
On behalf of Applicants,



Brian D. Gildea; Reg. No. 39,995